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#10

In re Application of	:
John J. Wille, Jr.	:
Serial No.: 09/694,393	: PETITION DECISION
Filed: October 23, 2000	:
Attorney Docket No.: 1194-011D	:

This letter is in regard to the petition (under 37 CFR 1.181) filed January 29, 2003, to withdraw the Notice of Abandonment. Applicant should note that the Serial Number on the petition is incorrect and delayed correlating the petition with the application file.

BACKGROUND

A review of the file history shows that this application was filed on October 23, 2000, and consisted of (according to the transmittal letter) 36 pages of specification and claims, 11 sheets of drawing, a 3 page declaration and a small entity filing fee and a return postcard. The drawings consisted of photomicrographs mounted on a Bristol Board backing. Upon receipt and processing of the application a Notice of Omitted Items was mailed to applicant on January 2, 2001. The missing item was identified as Figure 4A. On February 15, 2001, applicant replied by supplying a copy of Figure 4A and a petition to accept the omitted figure as having been part of the original filing, as evidenced by the Office date stamped return postcard which does not indicate that any figures are missing from the originally filed application papers. No formal decision on the petition appears in the record, however it appears that the petition was accepted and Figure 4A, as supplied with the petition, entered.

The examiner allowed the application on first action appending to the Notice of Allowability a requirement that missing Figure 1A be supplied. The Notice of Allowance and Issue Fee Due and the Notice of Allowability, both mailed to applicant on September 28, 2001, set a three month statutory period for paying the Issue Fee and supplying the additional drawing. The Issue Fee was timely paid on January 24, 2002. It appears that no reply to the requirements of the Notice of Allowability was made. A Notice of Abandonment was mailed to applicant on May 14, 2002, indicating that new formal drawings had not been received. Applicant then filed this petition on January 29, 2003.

DISCUSSION

All of the difficulties with this application revolve around the drawings. M.P.E.P. 608.02 sets forth drawing standards for photographic submissions, as follows:

(b) Photographs . —

(1) Black and white . Photographs, including photocopies of photographs, are not ordinarily permitted in utility and design patent applications. The Office will accept photographs in utility and design patent applications, however, if photographs are the only practicable medium for illustrating the claimed invention. For example, photographs or photomicrographs of: electrophoresis gels, blots (e.g., immunological, western, Southern, and northern), autoradiographs, cell cultures (stained and unstained), histological tissue cross sections (stained and unstained), animals, plants, in vivo imaging, thin layer chromatography plates, crystalline structures, and, in a design patent application, ornamental effects, are acceptable. If the subject matter of the application admits of illustration by a drawing, the examiner may require a drawing in place of the photograph. The photographs must be of sufficient quality so that all details in the photographs are reproducible in the printed patent.

Photographs or photomicrographs (not photolithographs or other reproductions of photographs made by using screens) printed on sensitized paper are acceptable as final drawings, in lieu of India ink drawings, to illustrate inventions which are incapable of being accurately or adequately depicted by India ink drawings, e.g., electrophoresis gels, blots, (e.g., immunological, western, Southern, and northern), autoradiographs, cell cultures (stained and unstained), histological tissue cross sections (stained and unstained), animals, plants, in vivo imaging, thin layer chromatography plates, crystalline structures, metallurgical microstructures, textile fabrics, grain structures and ornamental effects. The photographs or photomicrographs must show the invention more clearly than they can be done by India ink drawings and otherwise comply with the rules concerning such drawings.

Photographs submitted in lieu of ink drawings must comply with 37 CFR 1.84(b). There is no requirement for a petition or petition fee, and only one set of photographs is required. See 1213 O.G. 108 (Aug. 4, 1998) and 1211 O.G. 34 (June 9, 1998) and 37 CFR 1.84(b)(1).

Such photographs to be acceptable must be made on photographic paper having the following characteristics which are generally recognized in the photographic trade: double weight paper with a surface described as smooth with a white tint. **Note that photographs filed on or after October 1, 2001 may no longer be mounted on Bristol Board.** See 37 CFR 1.84(e) and 1246 O.G. 106 (May 22, 2001). If several photographs are used to make one sheet of drawings, the photographs must be contained (i.e., developed) on a single sheet.

Applicant supplied Bristol Board mounted photographs with the original application papers. However, it appears that the photographs were not securely mounted to the Bristol Board, as required. This is evidenced by the discovery in initial processing of a blank sheet of Bristol Board containing the legend "Fig 4A" but no photograph. One loose photograph was found with the papers. However, the Office cannot assume that the loose photograph is the one which should have been mounted on the blank sheet of Bristol Board. For this reason the Notice of Omitted Items was mailed to applicant. In response, a new Bristol Board mounted photograph was submitted.

During examination the examiner noted that Figures 1B-1D were present, but not Figure 1A. The specification does not mention a Figure 1A. Thus the omission of Figure 1A appears not to have been an oversight and the examiner's requirement that it be supplied in response to the Notice of Allowability was improper. However, applicant in any future applications should number and letter drawings beginning with number "1" and letter "A" so as to avoid confusion or questions as to whether a drawing figure is missing or not. During examination several other photographs have become detached from their Bristol Board mounting. Clearly the originally supplied photographs were not properly mounted on Bristol Board in a secure manner. As an application's specification and drawings are disassembled and individually processed during the printing process, the existence of loose photographs would inevitably lead to errors in printing, such as missing figures or incorrectly numbered figures. The examiner's requirement for new drawings is therefor maintained. Note also the bold portion of the section quoted above.

It is further noted that this petition was filed more than eight months after the Notice of Abandonment was mailed to applicant. 37 CFR 1.181(f) requires that petitions be filed within two months of the action complained of, in this case abandonment of the application. Failure to do so may be cause for dismissal of the petition. The time period is indicated as non-extendable. Applicant's petition indicates that the application has been discussed several times with the examiner. In consulting with the examiner, the examiner of record in this application fails to remember any discussions with applicant about this application. It may be that applicant spoke with other Office personnel, which remain unidentified, but applicant did not speak with the examiner of record. Nor does the petition indicate what the subject of any such discussions was. Other than the referred to discussions, no reasonable reason is given for the delay in filing this petition.

DECISION

Applicant's petition is **DISMISSED**. Applicant may submit a renewed petition requesting reconsideration of this decision upon satisfaction of the following conditions:

1. New drawings in compliance with the guidelines set forth above for photographic drawings must be submitted within TWO MONTHS of the mail date of this decision. No extension of this time period will be permitted.
2. A satisfactory explanation of the reason for delay in filing the original petition must be submitted.
3. A satisfactory reason for not filing a reply to the Notice of Allowability requirement for new drawings is also required. As noted in the Notice of Abandonment this application was held abandoned for failure to file new drawings, as required in the Notice of Allowability. This likely refers to the requirement to submit a Figure 4A, but may also be extended to apply to the poorly mounted photographs. In view of this requirement, applicant may wish to consider the filing of a petition under 37 CFR 1.137(a) or (b).

Any renewed petition must be submitted within TWO MONTHS of the mailing date of this petition decision in order to be considered timely. No extension of this time period will be permitted.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.



Bruce M. Kisliuk
Director, Technology Center 1600